



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

TM

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
--------------------	-------------	-----------------------	---------------------

09/478,702 01/06/00 VAN TASSEL

J 97-1804

EXAMINER

IM52/1004

ART. UNIT. IN PAPER NUMBER

8

ROBERT D. KUCLER, ESQ.  
REED SMITH LLP  
P.O. BOX 486  
PITTSBURGH PA 15230-0486

DATE MAILED:

10/04/01

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

#### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on \_\_\_\_\_.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1 - 31 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1 - 31 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been:

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1774

15

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally confusing and not understood. How is the tape formed? How is the material deposited and on what. This rises to enablement problems and applicants are requested to provide better claim language for examination.

16

Claims 18-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally confusing and not understood. How is method executed in manipulative steps? This rises to enablement problems and applicants are requested to provide better claim language for examination.

17

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 1774

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18

Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuguchi(4482447) alone.

The cited reference substantially teaches the claimed invention including an apparatus for making a particulate tape comprising a conductive carrier , means for applying electrical potential and an electrophoretic deposition bath containing counter electrodes- see fig 1; col 3, lines 19-57; col 7, lines 24-41; col 4, lines 22-56. Also, see entire reference. Concerning claim 31, it is submitted that it would have been obvious to provide additional baths in the cited reference to perform additional operations on the substrate and in the absence of unexpected results.

19

**Crystal Plaza Three Fax Center**

A facsimile center has been established in Crystal Plaza 3. The hours of operations are Mondays through Friday, 8:45 to 4:45 PM. This new location should be used in all instances when faxing

Art Unit: 1774

any correspondence to Group 1700. The Patent Examining Fax Center new telecopier numbers are (703) 305-3599 for all After Finals and 703-305-5408 for all others. Use of the new Crystal Plaza 3 center will facilitate rapid delivery of materials to the group. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 ( November 15, 1989).

**New!** Applicants who wish to send a facsimile for the examiner's immediate review can now do so by using the Examiner Dixon's personal fax number at 703-872-9514. **NOTE: All facsimiles sent to the examiner's personal fax number will be treated as informal and will not be entered in the related application unless otherwise noted by the examiner.**

**Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the receptionist whose number is (703)308-2351.**

20

Any questions concerning this communication should be directed to Examiner Dixon, at 703-308-0013, Mondays to Thursdays, between 12 noon and 6 PM, eastern time .



Merrick Dixon

Primary Examiner

Group 1700